

Appl. No. 10/644,280

Amdt. dated Aug. 23, 2005

Reply to Off. Act. dated Apr. 8, 2005 and Adv. Act. dated Aug. 19, 2005

REMARKS/ARGUMENTS

1. The Examiner rejected claims 1, 4, 5, 8, 10, 24, 26, and 27 under 35 U.S.C. § 102(b) as being anticipated by Di Meo et al. (U.S. Patent No. 2,823,056). Claims 2, 11, 25, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Meo et al. ("Di Meo") in view of Madej (U.S. Patent No. 4,417,711). Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Meo in view of Bartlett et al. (U.S. Patent No. 5,199,756). Claims 6, 7, and 9 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Claims 12-18 were indicated as being allowable. Reconsideration of this application is respectfully requested in view of the amendments and/or remarks provided herein.

Summary of Telephonic Interview Dated July 14, 2005

2. Applicant and his undersigned representative would like to thank the Examiner for taking the time to participate in a telephonic interview with Applicant's representative on July 14, 2005. During the interview, Applicant's representative and the Examiner discussed Di Meo and Madej as applied to claims 1, 24, 26, 27 and 29, as well as the Examiner's construction of the term "arranged to" in Applicant's claim 1. The Examiner and Applicant's undersigned representative did not come to any agreement with respect to claims 1-5, 8, 10, 11 (claims 6, 7, and 9 already being indicated as allowable if rewritten in independent form) and 24-28; however, the Examiner did indicate that claims 29 and 30 were allowable over the prior art of record based on, *inter alia*, claim 29's recitation of selective insulation/electrical contact exposure of the connector receiving member of the first cable tray and the connector receiving element of the second cable tray to facilitate electrical continuity between the cable trays.

During the discussion with respect to claim 1, Applicant's representative argued that Di Meo failed to disclose all the limitations of Applicant's claim 1 because Di Meo did not disclose or suggest a connector receiving member having two parallel sections "arranged to" at least receive at least a portion of a first fastener in the space therebetween. The Examiner indicated that he construed the claim term "arranged to" to be equivalent to the term "capable of." Thus, based on the Examiner's construction of the term "arranged to", the fairing element (29) of Di

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Meo is allegedly capable of receiving a fastener in the space (30) between its vertically separated plates. Applicant's representative explained that the term "arranged to" is distinct from the term "capable of" because the term "arranged to" requires some plan or intent to perform the specified function (in this case "at least receive" some or all of a fastener); whereas, "capable of" does not require such an intent or plan. As further explained below, Applicant disagrees that Di Meo's fairing element (29) is capable of receiving anything in the element's vertical grooves (30) other than the mesh bases of Di Meo's cable trays. However, more importantly, as also explained below, Applicant submits, as was done by Applicant's representative during the interview, that the Examiner's construction of the term "arranged to" to be equivalent to the term "capable of" is in error in view of judicial precedent.

Rejections under 35 U.S.C. § 102(b)

3. Claims 1, 4, 5, 8, 10, 24, 26, and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Di Meo. With respect to claim 1, the Examiner asserts that the fairing element (29) of Di Meo is equivalent to the claimed connector receiving member of claim 1 and that the fairing element (29) is arranged to receive at least a portion of a fastener in the groove or space (30) between plates of the fairing element (29). Although Di Meo clearly does not disclose or suggest that any fastener or portion thereof is, or even can be, received in the fairing element's groove (30), the Examiner submits that such groove is actually "arranged to" receive such a fastener or portion thereof. The Examiner's position was more clearly stated during the telephonic interview with Applicant's undersigned representative when the Examiner admitted that, while Di Meo's fairing element (29) had no structural arrangement or configuration evidencing any intent or plan for the element (29) to receive a fastener or portion thereof, the fairing element (29) met the recited claim limitation because the term "arranged to" was equivalent to the term "capable of" and one could force a fastener or portion thereof into the fairing element's groove--for example, by driving a nail into and through one or more of the vertically separated *metal* plates of the fairing element (29). Applicant disagrees.

Di Meo does not disclose or suggest that his fairing element (29) is adapted or arranged to receive any form of fastener or portion thereof. Di Meo's fairing element (29) is used solely "as a bridge over the raw traverse end edges of the bottoms of the connected channel components

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20a and also to strengthen the juncture transversely." See col. 2, lines 49-54. Moreover, the fairing element (29) is "struck from stiff plate metal" (see col. 2, lines 15-16); thus, inserting a fastener into the space (30) between the plates of the fairing element would require a substantial modification of the disclosed fairing element (29). For example, one of ordinary skill in the art could not simply pound a nail into the top of Di Meo's fairing element (29) as proposed by the Examiner because the fairing element (29) is constructed of "stiff plate metal," which construction would resist insertion of a nail. Therefore, in order for the space (30) between the plates of the fairing element (29) to even be "capable of" receiving any portion of a fastener, the fairing element (29) would have to be modified, for example, by drilling a hole in at least one plate of the element (29). Di Meo provides no such teaching or suggestion to so modify the fairing element (29).

More importantly, the Examiner's construction of Applicant's term "arranged to" to be equivalent to the term "capable of" is erroneous as a matter of law. In *Regents of the Univ. of Cal. v. Oncor, Inc.*, 44 U.S.P.Q.2d 1321, 1326 (N.D. Cal. 1997), the District Court evaluated construction of the patent owner's claimed term "designed to allow" in view of the alleged infringer's proposed interpretation of such term to mean "capable of." Referencing Webster's Third New International Dictionary, the Court found that the term "designed to allow," which Applicant submits is a broader term than Applicant's term "arranged to," is not the same as "capable of" because the term "design" means "to plan or have in mind as a purpose; intend." See *id.* Thus, the Court construed the term "designed to allow" to mean "intentionally selected to make possible the detection goals set forth in the claim." *Id.* The Court found that there was nothing in the file history or patent specification that contradicted the ordinary English definition of the disputed terms and accordingly refused to construe the term "designed to allow" to mean "capable of." *Id.*

Applicant uses the phrase "arranged to at least receive at least a portion of a first fastener in the space therebetween" in his claim 1. Applicant has not expressly defined the term "arranged to" in any manner in the patent specification or elsewhere to have any meaning other than its ordinary dictionary meaning. Thus, reference to the dictionary to interpret the disputed claim term is helpful. See *Phillips v. AWH Corp.*, Nos. 03-1269, 03-1286, 2005 WL 1620331, at \* 6 (Fed. Cir. July 12, 2005) (en banc). However, claim construction must not be done in a

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vacuum, but rather must be reasonable in view of the patent specification and prosecution history. See *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005). As the Federal Circuit explained just last month, "[t]he claims, of course, do not stand alone. Rather, they are part of 'a fully integrated written instrument, . . . , consisting principally of a specification that concludes with claims. For that reason, claims 'must be read in view of the specification, of which they are part'." *Phillips*, 2005 WL 1620331, at \* 7 (internal citations omitted). Besides the patent specification, the other claims of the patent application are also "valuable sources of enlightenment as to the meaning of a claim term." *Id.*

One of ordinary skill in the art reading Applicant's claimed term "arranged to" in the context of the claim and the patent specification would clearly not interpret such term to simply mean "capable of." First, the dictionary definition of the term "arrange" is "to put into a proper order or into a correct or suitable sequence, relationship, or adjustment." Merriam-Webster's Collegiate Dictionary 68 (11<sup>th</sup> ed. 2003). To put something into a proper order, sequence or relationship clearly invokes an intent or plan in order to establish the order, sequence or relationship into which the thing is put. Thus, similar to the term "designed" as construed by the Northern District of California, the term "arranged" has a plan or intent element. See *Regents of Univ. of Cal.*, 44 U.S.P.Q.2d at 1326.

By contrast, the dictionary definition of the term "capable" is "susceptible" or "having traits conducive to or features permitting." *Id.* at 182. "Susceptibility" or "having traits conducive to or features permitting" does not evoke any intent, plan, order, relationship, sequence, or adjustment at all. As a result, there is a distinct difference between something that is *in a proper or correct order or relationship* (i.e., "arranged to") as opposed to something that merely has *traits conducive to or features permitting* (i.e., "capable of"). As Applicant's undersigned representative noted during the telephonic interview, the latter is much broader than the former. In other words, while something that is specifically "arranged to" perform a function must always be "capable of" performing that function, the opposite is not true (i.e., that something that is merely "capable of" performing a function is not always "arranged to" perform that function). Thus, based purely on the dictionary definitions of "arrange" and "capable," the Examiner's construction of the claimed term "arranged to" to be equivalent to, and as broad as, the term "capable of" is erroneous.

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The error in the Examiner's claim construction is further exacerbated when the claimed term "arrange to" is considered in the context of the patent specification and other claims. See *Phillips*, 2005 WL 1620331, at \*6-7. Applicant's specification clearly discloses the preferred arrangement of Applicant's claimed cable tray and provides a clear example as to how the two parallel sections of the claimed connector receiving member may be "arranged to" receive at least part of a fastener in the space between them. For example, on page 15 of Applicant's specification, Applicant discloses one embodiment in which the connector receiving member includes a pair of transverse wire sections (18) separated by a space that is selected to allow a shank of a carriage bolt to pass through the space, but that prevents passage of the bolt head (23). See Applicant's Spec., p. 15, lines 6-17. Additionally, in a preferred embodiment, the wire sections (18) of the preferred connector receiving member are further arranged to engage the underside of the bolt head (23) such that the bolt head (23) cannot rotate while the nut (24) is being threaded on the bolt's shank. *Id.* at lines 6-8. Moreover, Applicant's claim 3 specifically recites that the two parallel sections of the connector receiving member are separated so as to receive and snugly engage a head of a carriage bolt such that rotation is prevented during threading of the nut, thereby providing additional assistance in understanding the meaning of Applicant's claimed term "arrange to." See *Phillips*, 2005 WL 1620331, at \*6-7. Therefore, based on the definition of the term "arrange" as considered in the context of Applicant's specification, one of ordinary skill in the art would clearly not equate the claimed term "arranged to" with the much more general term "capable of."

As a result, the Examiner's unduly broad construction of the claimed term "arrange to" is erroneous. Moreover, since the Examiner relied upon his erroneous claim construction to reject claim 1 in view of the disclosure of Di Meo, Applicant submits that claim 1 is not taught or suggested by Di Meo. Therefore, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn and claim 1 be passed to allowance because Di Meo fails to disclose or suggest, *inter alia*, a connector receiving element having two parallel sections

<sup>1</sup> Applicant's discussion of the preferred embodiment of the connector receiving member is not intended and should not be construed as limiting the claim to such embodiment. See, e.g., *Leggett & Platt, Inc. v. Hickory Springs Mfg. Co.*, 285 F.3d 1353, 1357 (Fed. Cir. 2002) (claim limitations should not be imported from the specification). Rather, such discussion is presented simply to help construe the term "arrange to" in the context of the specification as required under *Phillips*.

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"arranged to" at least receive at least a portion of a fastener in the space between them.

Claims 4, 5, 8, and 10 are dependent upon claim 1, which claim has been shown allowable above. Therefore, since claims 4, 5, 8, and 10 each introduce additional subject matter that, when considered in the context of the recitations of claim 1, constitutes patentable subject matter, Applicant respectfully submits that the recitations of claims 4, 5, 8, and 10 are not disclosed or suggested by Di Meo. Therefore, Applicant respectfully submits that claims 4, 5, 8, and 10 are in proper condition for allowance.

Regarding claim 24, Applicant has amended such claim to include the limitations of claim 25. Since the Examiner did not reject claim 25 under 35 U.S.C. § 102(b) in view of Di Meo, Applicant respectfully requests withdrawal of the rejection of claim 24 in view of Applicant's amendment. Since the subject matter added to claim 24 by amendment was considered by the Examiner with respect to the Examiner's prior examination of claim 25, Applicant submits that Applicant's amendment to claim 24 does not require any further search or consideration by the Examiner. Applicant addresses the Examiner's rejection of claim 25 under 35 U.S.C. § 103(a) below.

Regarding claims 26 and 27, Applicant has herein cancelled said claims.

Rejections under 35 U.S.C. § 103(a)

4. Claims 2, 11, 25, 29, and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Meo in view of Madej. Claims 2 and 11 are dependent upon claim 1, which claim has been shown allowable above. Therefore, since claims 2 and 11 introduce additional subject matter that, when considered in the context of the recitations of claim 1, constitutes patentable subject matter, Applicant respectfully submits that the recitations of claims 2 and 11 are not disclosed or suggested by Di Meo. Additionally, as explained in Applicant's previous response dated January 7, 2005, claim 2 has been amended to recite subject matter that is patentably distinct from the disclosure of Di Meo. For example, claim 2 requires that one or more of the two parallel sections of the connector receiving member includes insulated *and* electrically conductive portions, and that the electrically conductive portion is arranged to engage the fastener. Di Meo does not disclose or suggest that his lugs include both insulated and electrically conductive sections. Rather, Di Meo's lugs are metallic because they are welded to

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the sidewalls of the cable tray (*see* col. 2, lines 5-11). In addition, Madej discloses providing a coating over the entire element (e.g., a clamp member) to completely seal out the effects of moisture. Therefore, neither Di Meo nor Madej, whether taken individually or in combination, disclose or suggest the selective insulation/electrical contact exposure recited in claim 2. Accordingly, Applicant respectfully submits that claim 2 is not taught or suggested by Di Meo in view of Madej and is in proper condition for allowance.

Regarding claim 25, Applicant has cancelled such claim and incorporated the limitations of such claim into independent claim 24, thereby effectively re-writing claim 25 in independent form. In his rejection of claim 25, the Examiner asserted that it would have been obvious to one of ordinary skill in the art to selectively insulate the claimed connector receiving member based on the disclosure of Di Meo in view of the disclosure of Madej. However, upon further consideration of claim 29 during the telephonic interview conducted July 14, 2005, the Examiner agreed that Di Meo in view of Madej does not disclose or suggest selective insulating/electrical contact exposure of the connector receiving member and connector receiving element disclosed in that claim because Di Meo does not disclose or suggest that any portion of his cable tray is insulated and Madej discloses that his entire clamp member is coated to completely seal out the effects of moisture. Similar to the recitations of claim 29, claim 24, as amended, requires at least one of the parallel sections of the connector receiving member to be selectively insulated (i.e., include an insulated portion and an electrically conductive portion). Neither Di Meo nor Madej disclose or suggest such selective insulation (or equivalently selective exposure of an electrical contact). Therefore, Applicant submits that claim 24 is in proper condition for allowance.

Regarding claim 29, the Examiner makes the same assertion of obviousness with respect to that claim as was made with respect to claim 25. However, as discussed above, during the telephonic interview conducted July 14, 2005, the Examiner agreed that Di Meo in view of Madej does not disclose or suggest the selective insulating/electrical contact exposure of the connector receiving member and connector receiving element disclosed in claim 29. As a result, Applicant submits that claim 29 is in proper condition for allowance.

Claim 30 is dependent upon claim 29, which claim has been shown allowable above. Therefore, since claim 30 introduces additional subject matter that, when considered in the context of the recitations of claim 29, constitutes patentable subject matter, Applicant

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respectfully submits that the recitations of claim 30 is not disclosed or suggested by Di Meo in view of Madej. Therefore, Applicant respectfully submits that claim 30 is in proper condition for allowance.

5. Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Meo in view of Bartlett et al. ("Bartlett"). Claim 3 is dependent upon claim 1, which claim has been shown allowable above. Therefore, since claim 3 introduces additional subject matter that, when considered in the context of the recitations of claim 1, constitutes patentable subject matter, Applicant respectfully submits that the recitations of claim 3 are not disclosed or suggested by Di Meo in view of Bartlett. Additionally, claim 3 recites subject matter that is clearly patentably distinct from any disclosure or suggestion of Di Meo in view of Bartlett. For example, claim 3 requires the two parallel sections of the connector receiving member to include wires that are separated so as to receive and snugly engage a head of a carriage bolt such that the carriage bolt does not rotate during threading of a nut onto the bolt's shank. Neither Di Meo nor Bartlett remotely discloses or suggests the use of any comparable cable tray component because, *inter alia*, neither reference discloses or suggests the use of a carriage bolt to secure two trays together. That is, since neither Di Meo nor Bartlett remotely discloses or suggests use of a carriage bolt to secure two cable trays together, neither discloses or suggests spacing two wires so as to receive and snugly engage a head of a carriage bolt such that the carriage bolt does not rotate during threading of a nut onto the bolt's shank. Therefore, Applicant respectfully submits that claim 3 is in proper condition for allowance.

#### Allowed Claims

6. Applicant would like to thank the Examiner for indicating the allowability of claims 12-18 as previously presented and further indicating the allowability of claims 6, 7, and 9 if rewritten in independent form. However, for the foregoing reasons, Applicant believes that claims 1-5, 8, 10, 11, 24, and 28-30 are also allowable over the prior art of record.



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7. The Examiner is invited to contact the undersigned by telephone, facsimile or email if the Examiner believes that such a communication would advance the prosecution of the instant application. Please charge any necessary fees associated herewith, including extension of time fees (if applicable and not paid by separate check), to the undersigned's Deposit Account No. 50-1111.

Respectfully submitted,

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